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MAILED

MAY 25 2010

OFFICE OF PETITIONS

In re Application of
Claes Wallen et al.
Application No. 10/063,288
Filed: April 8, 2002
Attorney Docket No. 19497-0011001/P
16488 US00

:
: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT
:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)" filed January 27, 2009. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred eighty-three days to five hundred seventeen (517) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is five hundred seventeen (**517**) days. A copy of the updated PTA calculation, showing the correct determination, is enclosed.

On October 28, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is one hundred eighty-three (183) days. On January 27, 2009, applicants timely¹ submitted the instant application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is five hundred seventeen (517) days.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of one hundred eighty-three (183) days based on an adjustment for PTO delay of six hundred thirty-two (632) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1) reduced by applicants' delay of four hundred forty-nine (449) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b). The adjustment of 472 days and the reduction of thirty-two and ninety-one days has been reviewed and found to be correct.

¹ PALM records indicate that the Issue Fee was received in the Office on January 27, 2009.

Applicants dispute the reduction of two hundred thirty-seven (237) days attributed to applicant for failing to respond within three months to the non-Final Office Action mailed February 4, 2005 and dispute the reduction of eighty-nine (89) days attributed to applicant for the delayed filing of the Request for Continued Examination on October 8, 2007. Applicants further argue entitlement to ten (10) days patent term adjustment for Office delay on June 15, 2007 within the meaning of §1.702(a)(2). Finally, applicant argues that pursuant to 37 CFR 1.704(b), a period of fifty (50) days should have been deducted for applicant delay in the filing of the petition on December 27, 2005 and that for the mailing of the non-final Office Action on October 4, 2006, instead of one hundred sixty (160) days, three hundred thirteen (313) days should have been accorded for PTO delay.

With respect to the applicant delay for failure to respond, a response to a non-Final Office Action mailed February 4, 2005 was incorrectly listed as having been filed on December 27, 2005 instead of the receipt date of July 25, 2005 which was filed with a three month extension of time. A review of the application history reveals that no response to the non-Final Office Action mailed February 4, 2005 was considered timely filed by the Office and the application became abandoned. Applicants were advised of the abandonment by notice mailed September 7, 2005. In response, on December 27, 2005, applicants filed a petition to withdraw the holding of abandonment. The petition to withdraw the holding of abandonment was not filed within two months from the mailing date of a notice of abandonment. Thus, a period of fifty (50) days should have been deducted for applicant delay. See § 1.704(c)(4). Moreover, by decision mailed August 9, 2006, the petition was granted on the basis that applicants had shown that a proper response was filed on July 25, 2005. Thus, instead of a 237 day reduction for applicant delay pursuant to 37 C.F.R. §1.704(b), 82 days should have been accorded.

As a result of the improper receipt date for the response to the non-final Office Action, Applicants argue further an entitlement to an additional 153 days of PTA pursuant to 37 CFR 1.702(a)(2) due to inaction by the PTO from November 25, 2005 (4 months after the July 25, 2005 response to office action filed by Applicant) until the mailing of the second non-Final office action on October 4, 2006.

Applicant's argument is persuasive. 37 CFR 1.702(a)(2) provides that: Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken.

As the Office failed to take action in response to applicant's response within the time provided for in 37 CFR 1.702(a)(2), rather than 160 days, an adjustment to the Patent Term Adjustment should have been made in the amount of 313 days.

The Applicants argue that the Final Office Action mailed April 11, 2007 was re-mailed June 15, 2007 and the period for reply was restarted. A review of the application history reveals that applicants are correct. Any delay should be calculated based on the date of the Restarted Response Period and not based on the date of the mailing of the original Office action. As applicant's response was received within three months of the Letter Restarting Period for Response (the re-mailed Office action), there was no applicant delay within the meaning of 37 CFR § 1.704(b). In view thereof, it is concluded that with the filing of the Request for Continued Examination on October 8, 2007, applicants failed to engage in reasonable efforts to conclude processing or examination of the application by delaying in replying to the Final Office Action by 23 days and not 89 days. Accordingly, the period of reduction of should be 23 days for the period June 15, 2007 to October 8, 2007.

The correct patent term adjustment at the time of the mailing of the Notice of Allowance is five hundred seventeen days.

The Office thanks applicants for their good faith and candor in bringing these matters to the attention of the Office. The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office of Data Management has been advised of this decision. The application is, thereby, forwarded to the Office of Data Management for issuance of the application. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of Revised PALM Screen

Day : Sunday
Date: 5/23/2010

PALM INTRANET

Time: 14:36:23

PTA Calculations for Application: 10/063288

Application Filing Date:	04/08/2002	PTO Delay (PTO):	632
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	449
Post-Issue Petitions:	0	Total PTA (days):	517
PTO Delay Adjustment:	334		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
94	05/23/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	334		
78	10/28/2008	MAIL NOTICE OF ALLOWANCE			
77	10/23/2008	ISSUE REVISION COMPLETED			
76	10/23/2008	DOCUMENT VERIFICATION			
75	10/23/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
74	10/23/2008	NOTICE OF ALLOWABILITY			
70	10/16/2008	DATE FORWARDED TO EXAMINER			
69	10/08/2008	AMENDMENT AFTER FINAL REJECTION			
68	08/08/2008	MAIL FINAL REJECTION (PTOL - 326)			
67	08/06/2008	FINAL REJECTION			
66	06/26/2008	DATE FORWARDED TO EXAMINER			
65	06/05/2008	RESPONSE AFTER NON-FINAL ACTION		91	60
64	06/05/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
63	05/02/2008	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
62	05/01/2008	CORRESPONDENCE ADDRESS CHANGE			
61	12/18/2007	CORRESPONDENCE ADDRESS CHANGE			
60	12/06/2007	MAIL NON-FINAL REJECTION			
59	12/05/2007	NON-FINAL REJECTION			
58	10/12/2007	DATE FORWARDED TO EXAMINER			
57	10/08/2007	RCE- AF PROCESSED			
56	10/12/2007	DATE FORWARDED TO EXAMINER			
55	10/08/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)		89	39
54	10/12/2007	DISPOSAL FOR A RCE / CPA / R129			

53	10/08/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
49	10/08/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
48	09/27/2007	MAIL ADVISORY ACTION (PTOL - 303)			
47	09/25/2007	ADVISORY ACTION (PTOL-303)			
46	09/18/2007	DATE FORWARDED TO EXAMINER			
45	09/17/2007	AMENDMENT AFTER FINAL REJECTION			
44	09/17/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
43	09/18/2007	DATE FORWARDED TO EXAMINER			
42	09/17/2007	AMENDMENT AFTER FINAL REJECTION			
41	06/15/2007	MAIL NOTICE OF RESTARTED RESPONSE PERIOD			
40	06/13/2007	LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES)			
39	04/11/2007	MAIL FINAL REJECTION (PTOL - 326)			
38	04/06/2007	FINAL REJECTION			
37	02/15/2007	DATE FORWARDED TO EXAMINER			
36	02/05/2007	RESPONSE AFTER NON-FINAL ACTION		32	34
35	02/05/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
34	10/04/2006	MAIL NON-FINAL REJECTION	160		31
33	09/28/2006	NON-FINAL REJECTION			
32	08/17/2006	DATE FORWARDED TO EXAMINER			
31	12/27/2005	RESPONSE AFTER NON-FINAL ACTION		237	23
30	08/09/2006	MAIL NOTICE OF RESCINDED ABANDONMENT			
29	08/09/2006	NOTICE OF RESCINDED ABANDONMENT IN TCS			
28	08/09/2006	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
27	12/27/2005	PETITION ENTERED			
26	09/07/2005	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
25	09/03/2005	ABAND. FOR FAILURE TO RESPOND TO O. A.			
24	09/03/2005	CASE DOCKETED TO EXAMINER IN GAU			
23	02/04/2005	MAIL NON-FINAL REJECTION			
22	02/03/2005	NON-FINAL REJECTION			
21	12/07/2004	DATE FORWARDED TO EXAMINER			
20	11/26/2004	RESPONSE TO ELECTION / RESTRICTION FILED			

19	11/26/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
18	11/26/2004	WORKFLOW INCOMING AMENDMENT IFW			
17	09/22/2004	MAIL RESTRICTION REQUIREMENT	472		-1
16	09/20/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
15	03/24/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
14	03/24/2004	REFERENCE CAPTURE ON IDS			
13	09/16/2003	CASE DOCKETED TO EXAMINER IN GAU			
12.7	05/16/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	05/16/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	08/08/2003	TRANSFER INQUIRY TO GAU			
10	07/11/2003	TRANSFER INQUIRY TO GAU			
9	05/31/2002	APPLICATION DISPATCHED FROM OIPE			
8	05/30/2002	APPLICATION IS NOW COMPLETE			
7	05/16/2002	PAYMENT OF ADDITIONAL FILING FEE/PREEXAM			
6	05/16/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
5	04/19/2002	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
4	04/15/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
3	04/11/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	04/08/2002	ELECTRONIC FILING OF ORIGINAL APPLICATION PAPERS			
1	04/08/2002	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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